

REMARKS

Claims 1-12 are pending in this application. Claim 1 is amended, and claim 12 is cancelled.

Claims 1, 4, and 7-12 stand rejected under 35 USC 103(a) as unpatentable over Kawakami (U.S. Pat. No. 6,208,610) in view of Henderson (U.S. Pat. No. 4,844,614). Claims 2, 3, 5, and 6 stand rejected under 35 USC 103(a) as unpatentable over Kawakami and Henderson as applied to claims 1, 4, and 7-11 above, and further in view of Sipotz (U.S. Patent No. 5,903, 394). Applicant respectfully traverses all of these rejections.

Claim 1 is amended to recite “a projection for positioning the beam splitter at the attachment position by *directly* abutting the beam splitter” [Emphasis added]. Inserting the word *directly* clarifies the position of the claimed projection relative to other structures in claim 1. The amendment finds support in applicant’s specification (see page 19, lines 7-11 and page 22, lines 13-15). Claim 1 is further amended only for proper English grammar and usage and not for patentability reasons. Claim 12 is canceled because it is extraneous in light of what is claimed in claims 1-11.

Amended claim 1 recites “a plurality of through holes defined so as to be suitable for inserting therein a plurality of projection sticks for positioning the beam splitter.”

The Examiner asserts that Henderson teaches “a plurality of projection sticks for positioning the beam splitter.” The Examiner’s position on Henderson boils down to whether the adjusting screws function in the same manner as the claimed projection sticks in the context of this application. Applicant submits that the screws in Henderson function differently than the claimed projection sticks because the adjusting screws of Henderson only “determine a second plane in which the beam splitter is centered” (see column 3, lines 18-19). The first plane in Henderson is determined by another set of structures, the pointed pivot pins (see column 3, lines 13-14 and 31-35). The claimed projection sticks, in contrast, function to properly adjust the

beam splitter in two directions, displacing the beam splitter both horizontally and vertically (see applicant's specification, page 11, lines 23, 24, and page 19, lines 13-15).

The Examiner asserts that "the flat-ended adjusting screws of Henderson are an art recognized equivalent" to the claimed projection sticks. He seems to be saying that projection sticks can be defined so broadly as to encompass the adjusting screws 73 in Henderson. Applicant respectfully disagrees with the Examiner's assertion. The adjusting screws of Henderson only **indirectly affect** the positioning of the beam splitter because the "flat ends ... abut against the three points of the point pins when the holder is placed into the chamber" (see column 3, lines 14-17). Thus, the point pins in Henderson are the structures that are actually in contact with the beam splitter, instead of the adjusting screws. This is different from amended claim 1, in which no intervening structure separates the beam splitter and the claimed projection sticks.

The amendment to claim 1 inserts the word "directly" to describe the relationship between the projection and the beam splitter. The projection directly abuts the beam splitter and can be manipulated to adjust the beam splitter in or around the attachment position. The amendment finds support in applicant's specification where it is stated that the "projection comes into contact with neighboring two side surfaces of the beam splitter, for example" (see applicant's specification, page 26). On the other hand, the beam splitter in Henderson directly contacts a retainer. The retainer is not responsible for adjusting the beam splitter. Instead, a combination of structures, including the adjusting screws, the plunger screws, the pivot screws, the spring plungers, guide, and plate adjust the positioning of the beam splitter (see Henderson column 9, lines 39-45). Not all of these structures directly contact Henderson's beam splitter in the manner that applicant's claimed projection directly abuts the beam splitter. Therefore, applicant has overcome the references without altering the scope of the claim by positively claiming a feature not disclosed by Henderson. Thus, even if a person of ordinary skill in the art would have been motivated to combine Kawakami and Henderson, that person would not have

been able to arrive at the claimed invention. Accordingly, the Examiner has not met the requirements of a *prima facie* case of obviousness.

Not only does a structural difference preclude anticipation of applicant's claimed invention, but also the Examiner's motivation for combining the references is improperly based on hindsight. The Examiner alleges that the motivation for combining Kawakami and Henderson is adjusting the beam splitter "more accurately." Henderson is directed to an interferometer comprising a beam splitter, a beam splitter holder, a retainer, and a front and a rear door. Kawakami, on the other hand, is directed to an optical pickup device for reading and writing DVDs. The fact that both beam splitters can be adjusted by some mechanism is such a general motivation that it does not respond to the evidentiary burden that the Examiner must satisfy to sustain a *prima facie* case. The Examiner is simply picking and choosing beam splitters from vastly different industries when he selects a beam splitter that is intended for inclusion in a chemical industry device and a second beam splitter intended for insertion in a computer industry device. Neither reference provides any teaching or suggestion whatsoever to look to a different industry. Thus, without applicant's claims and disclosure as a roadmap, no person of ordinary skill in this art would have chosen Henderson's. Adjusting a beam splitter is so general in the context of the relevant art as to constitute no more than the reference to a general level of skill in the art found deficient in *In re Lee*, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002). Under *Lee*, the Examiner must present **specific evidence** of motivation, not the generalized allegation of motivation relied on in the pending Action. With Kawakami as the primary reference, a person of ordinary skill in the art would not have been motivated to combine Kawakami with Henderson when the invention was made. Likewise, were one of ordinary skill in the art to have started with the disclosure of Henderson, that person would not have been motivated to look to Kawakami when the invention was made. Thus, applicant requests that the Examiner withdraw his rejection because the Examiner has not met his burden of providing the specific evidence for motivation 35 USC 103(a) requires.

Claims 2, 3, 5, and 6 were rejected under 35 USC 103(a) over Kawakami and Henderson, further in view of Sipotz, which is cited only for its disclosure of adhesive housing recesses. Since Kawakami and Henderson do not render independent claim 1 unpatentable, adding Sipotz to reject claims 2, 3, 5, and 6 does not complete a *prima facie* case of obviousness. Thus, the rejection of claims 2, 3, 5, and 6 under 35 USC 103(a) should be withdrawn.

Early action allowing claims 1-11 in this application is solicited.

In view of the above, each of the claims in this application is in condition for allowance. Accordingly, applicant solicits early action in the form of a Notice of Allowance.

In the event that the transmittal letter is separated from this document and the Patent and Trademark Office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing Attorney Docket No. **259052003700**.

Dated: April 25, 2007

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